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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050789
Party	Defendant Hewlett-Packard Development Company, L.P.
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Dated: November 24, 2009

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

NARTRON CORPORATION,

Petitioner,

v.

HEWLETT-PACKARD DEVELOPMENT
COMPANY, L.P.,

Respondent.

Cancellation No. 92050789

Registration No. 3,600,880

Registration Date: April 7, 2009

Mark: **TOUCHSMART**

RESPONDENT HEWLETT-PACKARD
DEVELOPMENT COMPANY, L.P.'S
REPLY MEMORANDUM IN SUPPORT
OF ITS MOTION FOR SUMMARY
JUDGMENT

INTRODUCTION

The key factors determinative in this cancellation proceeding must be decided based on the parties' registrations, "regardless of what the record may reveal as to the particular nature of [the] goods, the particular channels of trade, or the class of purchasers to which sales of the goods or services are directed." *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1355, 56 U.S.P.Q.2d 1351, 1355 (Fed. Cir. 2000). Here, the respective registrations establish dispositive differences between the marks themselves and between the claimed goods that preclude a likelihood of confusion. Additionally, a divergence in the typical channels of trade for the claimed goods, the sophistication of consumers for such goods, and the common, descriptive character of the terms comprising Nartron's mark all reinforce that conclusion.

In its opposition, after briefly discussing the marks' commercial impressions (*see* Part A, below), Nartron asks the Board to look beyond the four corners of the registrations. In addressing the parties' goods, Nartron looks past the goods claimed in the registrations to argue that certain "product applications" that *use* or *embed* its claimed goods could intersect with HP's claimed goods. *See* Part B. In addressing trade channels, Nartron strays beyond the registrations to assert that *HP* utilizes all manner of trade channels for its numerous goods and services sold under other marks, instead of assessing what trade channels the *claimed goods* bearing the TOUCHSMART mark would normally move in. *See* Part C. In addressing distinctiveness, Nartron does not look to the terms actually comprising its SMART TOUCH mark, but instead asks the Board to measure distinctiveness solely by Nartron's record of enforcement. *See* Part D. Finally, Nartron asserts that a determination as to likelihood of confusion should await Nartron's investigation into HP's alleged intent in selecting the TOUCHSMART mark. *See* Part E.

As explained below, the Board need not follow Nartron down any of these detours, and need not resolve any disputed facts surrounding the parties' use or intent, to award summary

1 judgment. The registrations themselves confirm there is no likelihood of confusion.¹

2 ARGUMENT

3 As set forth below, applying the relevant *DuPont* factors to the parties' registrations
4 confirms that no likelihood of confusion arises from the simultaneous registration of
5 Nartron's SMART TOUCH mark and HP's TOUCHSMART mark.

6 A. HP's TOUCHSMART Mark Differs From Nartron's SMART TOUCH 7 Mark in Appearance, Sound, Connotation and Commercial Impression.

8 In our opening brief we established that HP's TOUCHSMART mark differs from
9 Nartron's SMART TOUCH mark in appearance, sound, connotation and commercial
10 impression. We noted that TOUCHSMART consists of a single ten-letter word rather than
11 two five-letter words, that it starts with (and emphasizes) "TOUCH" rather than "SMART,"
12 and that it sounds different from SMART TOUCH. See HP's Motion for Summary
13 Judgment ("Mot.") at 3-4.

14 Nartron attempts to sidestep these straightforward indications of the marks' visual and
15 aural dissimilarity, and instead, relying on *Bank of America National Trust & Savings Ass'n*
16 *v. American National Bank of St. Joseph*, 201 U.S.P.Q. 842 (T.T.A.B. 1978), argues only
17 that transposition does not necessarily create dissimilarity. See Nartron's Opposition Brief
18 ("Opp.") at 2-3. But that was not the principle the Board enunciated in that case. Instead,
19 the Board recognized that *sometimes* transposition creates a distinct commercial impression
20 and *sometimes* it does not. 201 U.S.P.Q. at 845 (citing, e.g., FLITE TOP for hosiery vs.
21 TOPFLITE for shoe soles, TALK O' THE TABLE for coasters, etc. vs. TABLE TALK for

22
23 ¹Nartron also takes HP to task for filing this motion for summary judgment rather than
24 engaging in substantial discovery into HP's use of the TOUCHSMART mark or intent in
25 adopting it. As set forth in its briefs, HP has a reasonable, good faith belief that the
26 registrations resolve the cancellation proceeding in its favor. It was hardly inappropriate for
27 HP, under the circumstances, to move for summary judgment before responding to Nartron's
28 extensive discovery requests; indeed, that is the whole point of summary judgment. See
Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 627 n.2, 222 U.S.P.Q. 741, 744 n.2
(Fed. Cir. 1984) (observing that disposition of cases through summary judgment "has much
to commend it. . . . Too often [the court] see[s] voluminous records which would be
appropriate to an infringement or unfair competition suit but are wholly unnecessary to
resolution of the issue of registrability of a mark").

1 periodicals, SQUIRETOWN for sport coats vs. TOWN SQUIRES for shoes, as examples of
2 transposed marks that evoke *different* commercial impressions).² While the marks that were
3 before the Board in that case—BANKAMERICA and AMERIBANC—conveyed a similar
4 commercial impression, that is not the case here, where the sequence of terms changes the
5 commercial impression from the adjective-noun SMART TOUCH (as in, “a smart touch”) to
6 the verb-based TOUCHSMART (as in, “to touch smart”). Nartron urges that its mark could
7 also be understood as an “adverb/verb combination,” but mental gymnastics of the sort
8 required to accommodate such a construction makes it unreasonable to assume that ordinary
9 consumers are likely to understand the mark that way.

10 In any event, the similarity of marks is not evaluated in a vacuum. In the
11 BANKAMERICA case, the Board considered the relationship of the parties’ services and
12 concluded that, *given the substantial similarity of services* offered in connection with the
13 marks (as stipulated by the parties), the differences between the marks were not enough to
14 preclude a likelihood of confusion. 201 U.S.P.Q. at 845; *see also Century 21 Real Estate*
15 *Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir.
16 1992) (when marks are used in connection with identical goods, “the degree of similarity
17 necessary to support a conclusion of likely confusion declines”). Likewise, the strength of a
18 mark bears on the significance of the similarities and differences of another mark. *See, e.g.,*
19 *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 U.S.P.Q. 108, 110
20 (C.C.P.A. 1974) (“the public easily distinguishes slight differences in the marks” where the
21 marks are “non-arbitrary” in nature or “widely used”).³ In this case, the disparate claimed

22 ²We cited additional examples in our opening brief. *See* Mot. at 4-5 (citing
23 determinations that SILKY TOUCH and TOUCH O’ SILK convey different commercial
24 impressions, as do FROSTY SEAS and SEAFROST, despite being used for similar goods).

25 ³*See also In re Box Solutions Corp.*, 79 U.S.P.Q.2d 1953, 1957-58 (T.T.A.B. 2006)
26 (because the marks’ common element—“box”—is highly suggestive, consumers likely to
27 notice differences between the marks); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432
28 F.2d 1400, 1401-02, 167 U.S.P.Q. 529, 530 (C.C.P.A. 1970) (common element of marks—
PEAK—“simply a common noun or adjectival word of everyday usage in the English
language” with “laudatory or suggestive indication”; consumers unlikely to confuse PEAK
PERIOD for deodorant with PEAK for dentifrice); *Sure-Fit Prods. Co. v. Saltzson Drapery*
Co., 254 F.2d 158, 160, 117 U.S.P.Q. 295, 297 (C.C.P.A. 1958) (no likelihood of confusion
(continued . . .))

1 goods and the “non-arbitrary” nature of the SMART TOUCH mark amplify the
2 dissimilarities of the marks themselves.

3 **B. Nartron’s Claimed Goods Are Not Related To HP’s Claimed Goods.**

4 We emphasized in our opening brief that the claimed goods in Nartron’s registration—
5 “electronic proximity sensors and switching devices”—are *internal* electronics, while HP’s
6 claimed goods—“personal computers, computer hardware, computer monitors, and
7 computer display screens”—are finished products. Nartron concedes this point when it
8 asserts that HP’s claimed products “*use*” or “*embed*” the electronic proximity sensors and
9 switching devices described in its registration. This establishes the dissimilarity of the
10 goods, not their similarity, for purposes of assessing a likelihood of confusion.⁴ The typical
11 consumer buying HP’s claimed products—*e.g.*, a personal computer or a computer
12 monitor—has no exposure to those products’ internal componentry, let alone the source of
13 such internal componentry.⁵ In precisely the same manner, an ordinary car purchaser could
14 not be confused by the simultaneous use of the mark SMART CAR for cars and the
15 (hypothetical) mark CARSMART for valve springs used inside automotive fuel injectors.
16 Even if those valve springs happen to be embedded in SMART CAR brand cars, the car
17 buyer would not know it and could not be confused by it.

18 The Board considered a similar situation in *Chase Brass & Copper Co. v. Special*
19 *Springs, Inc.*, 199 U.S.P.Q. 243 (T.T.A.B. 1978), where it determined that the simultaneous
20 use of an *identical* mark for distributor springs and for brass rod, both in the automotive

21 (. . . continued)

22 between SURE-FIT and RITE-FIT despite identical slip-cover products: “Where a party
23 uses a weak mark, his competitors may come closer to his mark than would be the case with
24 a strong mark without violating his rights”).

25 ⁴It is of limited relevance that one could group both parties’ claimed goods under a
26 broad category of ‘electronics’ or ‘technology.’ *Electronic Data Sys. Corp. v. EDSA Micro*
Corp., 23 U.S.P.Q.2d 1460, 1463 (T.T.A.B. 1992) (goods’ relatedness does not turn on
27 “whether a term can be used that describes them both” and it cannot be said “that a
28 relationship exists between goods and services simply because each involves the use of
computers”).

⁵A manufacturer of computers, monitors, etc, might be able to identify the source of
different internal electronics, but he or she could hardly be confused by them. *See* Mot. at 9-
10.

1 industry, would not create a likelihood of confusion, because one was a finished product and
2 the other was “a semi-finished product that would require machining and/or other processing
3 and would lose its trademark and the identity conveyed thereby by the time it reached a
4 finished state in products.” *Id.* at 245. Under those circumstances, just as in this case, there
5 could be very little chance that “the marks identifying the respective products of
6 [respondent] and [petitioner] would ever be encountered by the same persons in an
7 environment where a likelihood of confusion could occur.” *Id.*

8 To overcome this problem, Nartron looks beyond its claimed goods and asserts that “a
9 wide range of product applications” using its claimed goods are “positioned to intersect in
10 common product markets” with HP’s claimed goods. Opp. at 6-8. But the rule is well-
11 established that the similarity of goods must be assessed based on the registrations, not on
12 use. *E.g., M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1381, 78 U.S.P.Q.2d
13 1944, 1946 (Fed. Cir. 2006) (relatedness of goods turns on consideration of “the applicant’s
14 goods as set forth in its application, and the opposer’s goods as set forth in its registration”).
15 Nartron has not identified any finished products in its registration, much less any finished
16 products that relate to HP’s claimed goods.⁶ As to the electronic proximity sensors and
17 switching devices that are identified in Nartron’s registration, there is no meaningful
18 relationship with HP’s claimed goods, and no likelihood of confusion.

19 **C. Nartron’s Trade Channels Are Different From HP’s Trade Channels.**

20 We proposed in our opening brief that normal trade channels for “electronic proximity
21 sensors and switching devices” are different from the normal trade channels for “personal
22 computers, computer hardware, computer monitors, computer display screens.” See Mot. at
23 11. Although Nartron recites the rule that the analysis must turn on the identification of

24
25 ⁶Even if the Board could consider the purported “applications of SMART TOUCH
26 technology,” the likelihood of confusion would remain minimal. The only finished product
27 Nartron describes is an “operator interface” dating back to 1991. The more recent
28 automotive “applications” Nartron cites appear to be electrical components embedded in
systems, rather than finished products themselves. Nartron may well enjoy patent protection
over its “smart touch technology” but it does not appear to enjoy trademark protection in
connection with any line of finished products or so-called “product applications.”

1 goods in the registrations (Opp. at 8-9), it again looks past those goods and argues that “HP’s
2 customers . . . are in multiple trade channels.” *Id.* at 9. As a large company, HP obviously
3 provides many goods and many services, some of which may well be expected to move
4 through the sort of industry-specific channels (e.g., tradeshow, catalogs or directly
5 negotiated wholesale agreements) that electronic proximity sensors and switching devices
6 would typically move in.⁷ That is not relevant, however, if the normal trade channels for
7 HP’s *claimed* goods for its TOUCHSMART mark are retail stores. *See, e.g., In re RAM Oil,*
8 *Ltd., LLP*, Nos. 77280977, 77280981, 2009 TTAB LEXIS 586, at *11-*12 (T.T.A.B. Sept.
9 3, 2009) (not precedential) (presuming parties’ goods and services—oil and gas exploration
10 and production services vs. fuel and filling station services—“move in all channels of trade
11 normal for those goods and services” but making logical inference that “how and to whom
12 these goods and services are sold are likely to be different”); *Cognis Corp. v. Hana Co.*, No.
13 76558733, 2007 WL 683786, at *9 (T.T.A.B. Feb. 28, 2007) (not precedential) (citing
14 “fundamental dissimilarity” in trade channels and customers between finished toner and ink
15 products “obviously intended for home and office use by businesses and general consumers”
16 and synthetic lubricant products for industry consumers). To the extent that trade channels
17 can be defined on the basis of the goods claimed, this factor further diminishes the
18 possibility that the marks would ever be encountered by the same consumers in a context
19 where confusion could arise.

20 **D. Consumers of Nartron’s and HP’s Claimed Goods are Sophisticated.**

21 Nartron does not challenge HP’s observation that the degree of care typically exercised
22 in the purchase of proximity sensors and switching devices, and in the purchase of personal
23 computers and related accessories, diminishes still further any likelihood of confusion
24 arising from the simultaneous use of HP’s TOUCHSMART mark and Nartron’s SMART
25 TOUCH mark.

26
27 ⁷Indeed, the 10-K report that Nartron relies on lists a wide range of business units
28 responsible for numerous products and services immediately before the trade channels
discussion that Nartron quotes in its opposition brief.

1 **E. Nartron's SMART TOUCH Mark is Not Arbitrary or Distinctive.**

2 We explained in our opening brief how Nartron's SMART TOUCH mark is entitled to
3 a very narrow scope of protection (if any), such that even minor differences in another
4 party's mark are enough to obviate consumer confusion. Mot. at 5. Nartron does not
5 disagree that the terms making up its mark are common words of everyday usage, and does
6 not challenge the conclusion drawn from dictionary definitions and case law that the term
7 "SMART" has a meaning in the technology field that is recognized in the general language.
8 See Mot. at 6-7; *In re Finisar Corp.*, 78 U.S.P.Q.2d 1618, 1621 (T.T.A.B. 2006) (in
9 connection with technological devices, the term "smart" consistently "tells the consumer that
10 the product is highly automated and capable of computing information"), *aff'd*, 223 Fed.
11 App'x 984 (Fed. Cir. 2007); *In re Nartron Corp.*, 2000 TTAB LEXIS 566, at *8 (T.T.A.B.
12 Aug. 21, 2000) (not precedential) (similar); *In re Cryomedical Scis. Inc.*, 32 U.S.P.Q.2d
13 1377, 1378 (T.T.A.B. 1994) ("The 'computer' meaning of the term 'smart,' as is the case
14 with many 'computer' words, is making its way into the general language"); *Nartron Corp.*
15 *v. STMicroelectronics, Inc.*, 305 F.3d 397, 404, 64 U.S.P.Q.2d 1761, 1765 (6th Cir. 2002)
16 (Nartron's SMART POWER mark found to be generic).

17 The fact that some "SMART" registrations (like Nartron's) do not include a disclaimer
18 of the term "SMART" did not change the Board's determination in *In re Finisar, supra*, that
19 the term is merely descriptive. 78 U.S.P.Q.2d at 1621 & n.6 (observing that while the term
20 "SMART" had been disclaimed 128 times in Class 9 registrations, still other "SMART"
21 marks may well have been registered based on acquired distinctiveness or registered on the
22 supplemental register).⁸

23 Instead of addressing the distinctiveness of its mark, Nartron counters that it has
24 pursued a number of enforcement actions over the years, which reinforce the strength of its
25 mark. Opp. at 11. It is hard to see how aggressive enforcement could ever be an adequate

26 _____
27 ⁸Of the current "SMART" registrations in Class 9, 148 include a disclaimer of any
28 exclusive right to use that term. Likewise, "TOUCH" has been disclaimed in forty Class 9
registrations.

1 substitute for distinctiveness, but to the extent enforcement enhances a mark's strength it is
2 by curbing third party use. See 2 J. Thomas McCarthy, *McCarthy on Trademarks and*
3 *Unfair Competition* §11:91 (4th ed. 2009). There is no evidence that Nartron has taken any
4 enforcement actions to prevent third party use (as opposed to registration) of "SMART
5 TOUCH," that Nartron has actually succeeded in stemming third party registration of
6 "SMART TOUCH" marks, or that Nartron took any action at all concerning the prior use
7 and registration of "TOUCHSMART" by Sears, Roebuck for an "electronic touch sensitive
8 device" used to control microwave ovens.⁹ Thus, even if the Board looks past the
9 registration itself to measure the distinctiveness of SMART TOUCH, Nartron's evidence in
10 that regard is equivocal at best.

11 **F. HP's Intent Need Not Be Assessed In Order To Grant Summary Judgment.**

12 Finally, Nartron argues that intent is a fact-intensive question poorly suited to
13 disposition on summary judgment. Opp. at 10. It is also an immaterial question in this case,
14 because other key factors are dispositive. *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d
15 330, 333, 21 U.S.P.Q.2d 1142, 1144-45 (Fed. Cir. 1991) (dispute over fact which would not
16 alter the likelihood of confusion decision will not prevent entry of summary judgment). It is
17 not readily apparent what Nartron intends for the Board to infer about HP's intent based on
18 the 1991 "Operator Interface" flyer,¹⁰ but the Board need not resolve it in order to grant
19 summary judgment.

20
21 ⁹There is also no indication among the records available through the Trademark
22 Document Retrieval system, including Sears' June 2001 office action response, that the
23 examining attorney cited to Nartron's SMART TOUCH mark as a source of potential
confusion during the prosecution of Sears' mark. That of course is true here too. The
examining attorney initially expressed concern over INTELLITOUCH (U.S. Registration
No. 1532779) for touch screens and related items, but did not cite Nartron's mark.

24 ¹⁰If Nartron's theory is that HP somehow found its inspiration to use TOUCHSMART
25 in connection with its *touch screen* computers and accessories from a flyer for an "Operator
26 Interface" that Nartron purportedly submitted as a specimen *eighteen years ago*, even though
27 that specimen is not available through the PTO website, even though subsequent Nartron
28 specimens (which are online) give no hint of *any* product application, and even though HP
had already been using the related PHOTOSMART, COPYSMART, ZOOMSMART and
COLORSMART marks for computer peripherals, software, digital cameras, printers and
scanners (U.S. Reg. Nos. 2,362,503, 2,330,058, 2,232,611, 1,625,722) for a decade when it
adopted the TOUCHSMART mark, its misgivings over HP's intent need not be indulged.

1 **CONCLUSION**

2 For all of the foregoing reasons, the Board should grant HP's motion for summary
3 judgment and deny Nartron's petition to cancel the TOUCHSMART mark.

4
5 DATED: November 24, 2009.

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